REMARKS/ARGUMENTS

In the Office Action mailed August 7, 2007 (hereinafter, "Office Action"), claims 1-29 stand rejected under 35 U.S.C. § 103. Claims 1, 8, 11, 12, 18, 21 and 27 have been amended. Claims 5-7, 10, 15-17, 20, 24-26 and 29 have been canceled.

Applicants respectfully respond to the Office Action.

I.   **Claims 1-11 Rejected Under 35 U.S.C. § 103**

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,142,318 to Lopez et al. (hereinafter, "Lopez") in view of U.S. Patent No. 7,173,724 to Nomura et al. (hereinafter, "Nomura"). Applicants respectfully traverse.

The factual inquiries that are relevant in the determination of obviousness are determining the scope and contents of the prior art, ascertaining the differences between the prior art and the claims in issue, resolving the level of ordinary skill in the art, and evaluating evidence of secondary consideration. KSR Int'l Co. v. Teleflex Inc., 550 U.S. ___, 2007 U.S. LEXIS 4745, at **4-5 (2007) (citing Graham v. John Deere Co. of Kansas City, 383 U.S. 1, 17-18 (1966)). To establish a *prima facie* case of obviousness, the prior art references "must teach or suggest all the claim limitations." M.P.E.P. § 2142. Moreover, the analysis in support of an obviousness rejection "should be made explicit." KSR, 2007 U.S. LEXIS 4745, at **37. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." Id. (citing In re Kahn, 441 F.3d 977, 988 (Fed. Cir. 2006)).

Applicants respectfully submit that the claims at issue are patentably distinct from the cited references. The cited references do not teach or suggest all of the subject matter in these claims.

Claim 1, as amended, recites

> providing a user interface at the scanner for a user to approve the scan job, or
> > rescan the plurality of pages, or edit settings for the scan job, or
> > cancel the scan job;
> receiving user input through the user interface at the scanner, wherein the
> > user input comprises one of the following: (a) input to approve the

> scan job, (b) input to rescan the plurality of pages, (c) input to edit
> settings for the scan job, or (d) input to cancel the scan job; and
> sending the scan job to a remote computer or computer peripheral on a
> network if the user input was the input to approve the scan job,
> whereby enabling the user to proof the scan job before sending the
> scan job to the remote computer or the computer peripheral on the
> network.

Lopez, alone or in combination with Nomura, does not teach or suggest this subject matter. Instead Lopez states that the "marked proof sheet is scanned so as to determine marked selection areas, and the image files associated with the marked selection areas are printed." (Lopez, col. 2, lines 37-39.) Lopez further states that "[t]he printing system preferably includes subsystems which obtain certain image files associated with a specified web page, print a proof sheet associated with those images, allow the user to select which of the images are to be printed, and print these user-selected image files." (Lopez, col. 3, lines 44-49.) Regarding the purpose of the invention in Lopez, Lopez states that "there is illustrated a printing system constructed in accordance with the present invention which enables digital images associated with Internet web pages to be previewed, selected, and printed without the need for a computer attached to the printer." (Id., col. 3, lines 40-44.) Additional details about the invention in Lopez are illustrated by the following:

> After the user chooses selected ones of the qualified image files 2 for
> printing by marking the user-designation areas 54 associated with the indicia
> 52 of the selected image files 2, the user places the marked proof sheet 22 on
> a scan platen 122 where it is optically scanned by a scanner subsystem 86.
> The scanned image is communicated from the scanner subsystem 86 to a
> proof sheet analyzer subsystem 82. The proof sheet analyzer subsystem 82
> detects and interprets the markings made by the user in the user designation
> areas 54 (also known as image selection areas 54) to identify the user-selected
> image files 2, and associates each of the individual user designation areas 54
> with a corresponding image file URL 73 via the identity marker 60. The proof
> sheet analyzer subsystem 82 then provides the image file URLs 73 to the
> internet access subsystem 70 in order to obtain the user-selected image files 2
> from the network 205.

Lopez, col. 5, lines 8-23. However, Lopez does not teach or suggest all of the subject matter in claim 1, as amended because Lopez does not teach or suggest "providing a user interface at the scanner for

a user to approve the scan job, or rescan the plurality of pages, or edit settings for the scan job, or cancel the scan job; receiving user input through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job; and sending the scan job to a remote computer or computer peripheral on a network if the user input was the input to approve the scan job, whereby enabling the user to proof the scan job before sending the scan job to the remote computer or the computer peripheral on the network."

The addition of Nomura does not overcome the deficiencies of Lopez. Instead Nomura states:

> The image forming system 1 is provided with a printer 2, which is a core part of the image forming system, and is further provided with a scanner 3, an automatic document feeder 4, a sheet post-treatment apparatus 5, a multi-staged sheet feeding unit 6, a relaying unit 8 and a both-side conveying unit 10, in order to have extended functions. The scanner 3, as well as the automatic document feeder 4 placed on a top of the scanner 3, is supported by system racks 7, so as to have a location above the printer 2 and the sheet post-treatment apparatus 5.

Nomura, col. 6, lines 17-25. Nomura's disclosure of a scanner, an automatic document feeder, and a sheet post-treatment apparatus does not teach or suggest all of the subject matter of claim 1, as amended. Nomura does not teach or suggest all of the subject matter in claim 1, as amended because Nomura does not teach or suggest "providing a user interface at the scanner for a user to approve the scan job, or rescan the plurality of pages, or edit settings for the scan job, or cancel the scan job; receiving user input through the user interface at the scanner, wherein the user input comprises one of the following: (a) input to approve the scan job, (b) input to rescan the plurality of pages, (c) input to edit settings for the scan job, or (d) input to cancel the scan job; and sending the scan job to a remote computer or computer peripheral on a network if the user input was the input to approve the scan job, whereby enabling the user to proof the scan job before sending the scan job to the remote computer or the computer peripheral on the network."

In view of the foregoing, Applicants respectfully submit that claim 1 is patentably distinct from Lopez and Nomura. Accordingly, Applicants respectfully request that the rejection of claim 1 be withdrawn because Lopez, alone or in combination with Nomura, does not teach or suggest all of the subject matter of claim 1.

Regarding claims 2-11, claims 2-4, 8-9 and 11 depend either directly or indirectly from claim 1. Claims 5-7 and 10 have been canceled. Accordingly, Applicants respectfully request that the rejection of claims 2-4, 8-9 and 11 be withdrawn.

II.   Claims 12-20 Rejected Under 35 U.S.C. § 103

Claims 12-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez in view of Nomura. Applicants respectfully traverse. The standard to establish a *prima facie* case of obviousness is provided above. See M.P.E.P. § 2142.

Claim 12 includes subject matter similar to the subject matter of claim 1. As such, Applicants submit that claim 12 is patentably distinct over Lopez in view of Nomura for at least the same reasons as those presented above in connection with claim 1 and request that the rejection of these claims be withdrawn.

Regarding claims 13-20, claims 13-14 and 18-19 depend either directly or indirectly from claim 12. Claims 15-17 and 20 have been canceled. Accordingly, Applicants respectfully request that the rejection of claims 13-14 and 18-19 be withdrawn.

III.   Claims 21-29 Rejected Under 35 U.S.C. § 103

Claims 21-29 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Lopez in view of Nomura. Applicants respectfully traverse. The standard to establish a *prima facie* case of obviousness is provided above. See M.P.E.P. § 2142.

Claim 21 includes subject matter similar to the subject matter of claim 1. As such, Applicants submit that claim 21 is patentably distinct over Lopez in view of Nomura for at least the

same reasons as those presented above in connection with claim 1 and request that the rejection of these claims be withdrawn.
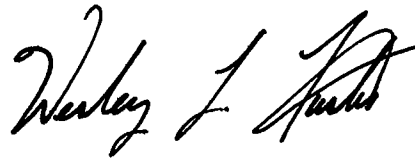
Regarding claims 22-29, claims 22-23 and 27-28 depend either directly or indirectly from claim 21. Claims 24-26 and 29 have been canceled. Accordingly, Applicants respectfully request that the rejection of claims 22-23 and 27-28 be withdrawn.

IV.   Conclusion

Applicants respectfully assert that all pending claims are patentably distinct from the cited references, and request that a timely Notice of Allowance be issued in this case. If there are any remaining issues preventing allowance of the pending claims that may be clarified by telephone, the Examiner is requested to call the undersigned.

Respectfully submitted,

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